

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

P2614US00

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Application Number

10/557,820

Filed

November 23, 2005

First Named Inventor

Kwan Young HAN

Art Unit

2894

Examiner

TRAN, TONY

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/hae-chan park/

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Signature

Hae-Chan Park

Typed or printed name

☒ attorney or agent of record.
Registration number 50,114

703-288-5105

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

January 27, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Kwan Young HAN, *et. al.*

Serial No.: 10/557,820

Confirmation No.: 2544

Filed: November 23, 2005

Docket No.: P2614US00

Group Art Unit: 2894

Examiner: TRAN, TONY

For: **LIGHT EMITTING DIODE PACKAGE AND LIGHT EMITTING DIODE SYSTEM
HAVING AT LEAST TWO HEAT SINKS**

Mail Stop: AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Final Office Action of October 27, 2009 ("Final Office Action") and the Advisory Action of January 22, 2010 ("Advisory Action"), Applicants respectfully request review of the above referenced application prior to the filing of an appeal brief because the rejections of record are clearly not proper and are without basis.

I. 35 U.S.C. § 103(a) rejection of claims 1 and 16

Independent claims 1 and 16 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,335,548 issued to Roberts, *et al.* ("Roberts") in view of U.S. Patent No. 6,590,343 issued to Pederson ("Pederson"). Applicants respectfully traverse these rejections for at least the following reasons.

The examiner fails to establish a *prima facie* case of obviousness of claims 1 and 16 at least because the examiner can not reasonably rely on the cathodes of Robert's dies 1910 and 1911 to teach the heat sinks of claims 1 and 16 (Final Office Action, page 12, lines 10-12).

Please refer to Applicants' remarks on pages 6-10 of Applicants' Reply dated June 24, 2009, which respond to the Non-Final Office Action dated April 28, 2009, and pages 6-8 of Applicants' Reply dated January 13, 2010, which respond to the Final Office Action. Applicants respectfully submit that the examiner fails to establish a *prima facie* case of obviousness for at least the reasons noted in those remarks.

II. Applicants' Response to the Advisory Action

The Advisory Action fails to shore up the Final Office Action's deficiencies. In fact, the Advisory Action exposes the flaws in the examiner's rejections of claims 1 and 16. Specifically, the examiner defines "heat sink" as anything that is "SINKING THE HEAT" (Advisory Action, Continuation Sheet). Here, the examiner does not cite any portion of Applicants' specification that supports this definition of "heat sink," nor does the examiner cite any dictionary, technical or otherwise, that supports this definition of "heat sink."

Applicants understand that examiners are to give claim terms their broadest reasonable interpretation during prosecution. This mandate, however, does not give the examiner *carte blanche* to interpret claim terms according to the examiner's whim. Rather, the examiner's interpretation must be consistent with the specification, and it "must also be consistent with the interpretation that those skilled in the art would reach" MPEP § 2111 (emphasis added).

The examiner's definition of "heat sink" as anything that is "sinking the heat" clearly fails both tests. Further, the examiner has failed to provide any objective evidence that supports the examiner's definition. Thus, this arbitrary analysis can not possibly support a *prima facie* case of obviousness of claims 1 and 16.

Moreover, the examiner then adds confusion to the record by stating that "THE WHOLE 501-505, [FIG. 5] ARE CONSIDERED AS A HEAT SINK BECAUSE THEY ARE "SINKING THE HEAT" ... (Advisory Action, Continuation Sheet). First, this new ground of rejection contradicts

the examiner's earlier position that the cathodes of Robert's dies 1910 and 1911 teach the heat sinks of claims 1 and 16 (Final Office Action, page 12, lines 10-12). Second, Applicants respectfully submit that "THE WHOLE 501-505, [FIG. 5]" does not teach the at least two heat sinks of claims 1 and 16, and the examiner has failed to provide any analysis as to how "THE WHOLE 501-505, [FIG. 5]" teaches the at least two heat sinks of claims 1 and 16.

Finally, Applicants do not dispute that Roberts teaches that heat extraction member 204 may be made of ceramic (col. 9, line 67 – col. 10, line 3). But in Roberts's embodiment of Fig. 19A, the heat extraction member 204 can not be made of ceramic. According to Roberts, "[e]lectrical contact to the cathode of each die is made through the base of the die, each which is electrically and mechanically bonded to the heat extraction member" (col. 29, line 67 - col. 30, line 3; emphasis added). If the heat extraction member of Fig. 19A were made of ceramic, then the dies 1910 and 1911 could not be electrically bonded to it (see Roberts, col. 29, lines 18-21 & col. 29, line 67 - col. 30, line 4). Hence, the examiner inappropriately relies on the heat extraction member 204 of Fig. 19A to teach the insulation main body of claims 1 and 16.

III. Applicants respectfully submit that the rejections of record discussed above are clearly not proper and are without basis and that all grounds for rejection have been overcome or rendered moot. Accordingly, Applicants submit that all pending claims are allowable and that the application is in condition for allowance. Prompt and favorable consideration of this Pre-Appeal Brief Request for Review is respectfully requested.

Respectfully Submitted,

/hae-chan park/

Hae-Chan Park
Reg. No. 50,114

Date: January 27, 2010
CUSTOMER NUMBER: 58027
HCP/RTS/tmk